

MP0107

09/348,865

PATENT

REMARKS

Claims 1-5 and 7-28 remain in connection with the present application.

Allowable Subject Matter

Initially, Applicants note that each of the claims of the present application have been allowed over the prior art and each of the claims are completely allowable, except for claims 1, 3, 17 and 18, and claims dependent thereon, which have been rejected under 35 U.S.C. §112, second paragraph. As Applicants believe that the rejection under 35 U.S.C. §112, second paragraph is without merit, an early indication of the allowance of each of claims 1-5 and 7-28 pending in connection with the present application is earnestly solicited.

Application Status

The claims of the present application have been rejected for a fourth time, each in a non-final Office Action. In response to the third non-final Office Action, Applicants filed an Appeal Brief on March 23, 2004. In response thereto, the Examiner once again acknowledged the allowability of the pending claims, without amendment, over the prior art of record. Thus, all prior art rejections which have been applied at various stages of the prosecution in connection with the present application have been withdrawn.

Instead of allowing the claims of the present application, however, the Examiner has rejected a few of the claims of the present application under 35 U.S.C. §112, second paragraph. As this rejection is also without merit as will be explained as follows, Applicants respectfully request an end to the prolonged piecemeal prosecution of the

MP0107

09/348,865

PATENT

present application and a quick and early indication of the allowability of each of claims 1-5 and 7-28 of the present application.

Claim Rejections under 35 U.S.C. §112, second paragraph

The Examiner has rejected claims 1,3 and 17-18 under 35 U.S.C. §112, second paragraph. These rejections are respectfully traversed as they are clearly without merit and should be withdrawn as will be explained as follows.

Initially, Applicants direct the Examiner's attention to MPEP § 2173.02 and 2173.05(e). As set forth in MPEP § 2173.02, the Examiner's focus during the examination of the claims for compliance with the requirements under 35 U.S.C. §112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether a more suitable language or modes of expression are available. Further, the section states that when the Examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the Examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness.

Thus, as patentable subject matter has clearly been defined in connection with the present application, as indicated by the Examiner's withdrawal of all outstanding prior art rejections in connection with the present application, as long as Applicants have defined the claims with a reasonable degree of particularity and distinctness, the claims should be allowed. Applicants respectfully submit that the claims, in their current condition, are clearly understandable and have been defined with such a reasonable degree of particularity and distinctness, and thus should be allowed in their current form.

MP0107

09/348,865

PATENT

Again, referring to MPEP § 2173.02, it also states that some latitude in the manner of expression of terms should be permitted, even though the claim language is not as precise as the Examiner might desire. Applicants respectfully request the Examiner to grant this latitude, even though the Examiner might desire that amendments be made to the claims.

The Examiner has alleged, with regard to various limitations of claims 1, 3, 17 and 18, that there is insufficient antecedent basis for various limitations in the claim. MPEP § 2173.05(e) discusses lack of antecedent basis, and it states that failure to provide explicit antecedent basis for terms does not always render a claim indefinite. It states that "[I]f the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite." Citing *ex parte* Porter, 25 USPQ2D 1144, 1145 (Bd. Pat. App. & Inter. 1992). As Applicants believe that the scope of each of claims 1, 3, 17 and 18 is are reasonable ascertainable by those of ordinary skill in the art, claims 1, 3, 17 and 18 are non-indefinite and should not be rejected for lack of antecedent basis under 35 U.S.C. §112, second paragraph. **Accordingly, each of the Examiner's rejections of claims 1, 3, 17 and 18 should be withdrawn.**

Specifically referring to the rejection of claim 1, the Examiner alleges that the limitation "said other ports" in line 15 is indefinite. Applicants note that line 14 refers to "other ports", in the form of "N-1 other ports". As there are clearly "N ports" present, and as the claim is referring to one of "said other ports", the claim is clearly referring to one of the "N-1 other ports". Thus the claim has been defined with reasonable particularity, and Applicants submit that the scope of the claim would be reasonably ascertainable by those of ordinary skill in the art. Thus, the claim is not indefinite and

MP0107

09/348,865

PATENT

does not lack antecedent basis in its current form. Accordingly, withdrawal of this rejection is respectfully requested.

With regard to claim 3, the Examiner alleges that the limitation "said device output buffers" in lines 2-3 lacks antecedent basis. Similarly, however, with regard to claim 3, the corresponding independent claim refers to each device additionally comprising "N-1 device output buffers, one per the N-1 other ports of said crossbar". Thus, in referring to "removing data from at least one of said device output buffers" as set forth in claim 3, the limitation can only be referring to the "N-1 device output buffers" in independent claim 2. Thus, the scope of the claim is reasonably ascertainable and the claim has been defined with a reasonable degree of particularity and distinctness as required by 35 U.S.C. §112, second paragraph. Accordingly, the claim is not indefinite and the rejection should be withdrawn.

Finally, regarding claims 17 and 18, the Examiner alleges that line 6 of the claim, referencing "said N-1 ports", allegedly lacks antecedent basis. However, when viewing the context of this limitation, the limitation actually refers to "N-1 output buffers each corresponding to another one of said N-1 ports" in claim 17, wherein N ports have already been defined. Thus, "another one of said N-1 ports" is clearly proper as the output buffers do not correspond to the N ports, but correspond to the other ports, namely the N-1 ports.

Similarly, claim 18 refers to "N-1 output buffers means each corresponding to another one of said N-1 port means", wherein port means have already been defined. Thus, the claim is referencing the other N-1 port means, and not each of the port means.

MP0107

09/348,865

PATENT

As the scope of each of claims 17 and 18 is reasonably ascertainable, in that each of the claims have been defined with a reasonable degree of particularity and distinctness, withdrawal of the Examiner's rejection is respectfully requested.

Accordingly, withdrawal of all outstanding rejections and allowance of each of claims 1, 3, 17 and 18, and all claims dependent thereon is respectfully requested.

Additional Comments

The Examiner includes an interview summary form for an interview conducted on June 23, 2004 between Examiner Ronald Abelson and Eric Janofsky. Mr. Janofsky is an attorney for the Assignee of the present application. The interview reflects one of several telephonic interviews between Examiner Abelson and Mr. Janofsky and/or the undersigned, wherein the Examiner was attempting to obtain permission to amend many of the claims to correct what the Examiner perceived as 35 U.S.C. §112, second paragraph problems. No agreement was reached in any of these interviews, as Applicants indicated to the Examiner that MPEP § 2173.02 and 2173.05(e) required only a reasonable degree of particularity and distinctness, which was already present in each of the claims of the present application.

Despite the fact that the claims of the application had never been rejected under 35 U.S.C. §112, second paragraph in any of the three previous non-final Office Actions; despite the fact that two personal interviews were conducted; and despite the fact that Applicants had to file an Appeal Brief in response to the third non-final Office Action wherein, for the third time, the Examiner was convinced that the claims were allowable over the prior art of record, the Examiner still refused to allow the claims of the present application. Instead, the Examiner issued the Office Action of July 2, 2004, wherein all

MP0107

09/348,865

PATENT

rejections were withdrawn and only 4 claims were rejected for minor informalities under 35 U.S.C. §112, second paragraph.

Further, the Examiner's interview summary record does not properly reflect the substance of the aforementioned interviews, but instead alleges that claims 16 and 27 of the present application were discussed and alleges that "N-1 output buffers" in the claims is intended to refer to figure 4, boxes A, B and C. Applicants wish to clarify the record in connection with the present application and to avoid any misunderstandings by noting that each of claims 16 and 27, and indeed each of the claims of the present application, are not limited to disclosure of any one figure. In particular, claims 16 and 27 are not limited to figure 4, and the limitation "N-1 output buffer" is not limited in any way to figure 4, boxes A, B and C. At best, the aforementioned figure illustrates exemplary embodiment which may provide support to the claim limitations. Thus, the claims of the present application should not be limited, in any way, by the statements made in the Examiner's interview summary record.

Comments on the Examiner's Statement of Reasons for Allowance

In the Examiner's Office Action, the Examiner further acknowledges the allowability of each of the claims of the present application over the prior art, and includes some indication of what a new piece of prior art, U.S. Patent No. 6,226,292 allegedly teaches or does not teach. While Applicants do not dispute that each of claims 1-5, and 7-28 of the present application are allowable over this new piece of prior art, and that they are allowable over each of the pieces of prior art cited by the Examiner during the prosecution in connection with the present application, Applicants do not necessarily agree with the Examiner as to what the prior art allegedly teaches. These allegations are

MP0107

09/348,865

PATENT

merely the Examiner's opinion and as the piece of prior art has not been used to reject any of the claims of the present application, further comments by Applicants need not and will not be provided.

Regarding the aspects of the claims of the present application which the Examiner acknowledges that the DiPlacdio patent does not teach, Applicants note that each of the claims of the present application should be interpreted individually, based only upon limitations present therein. Thus, to the extent that the Examiner references any limitations which are not expressly present in any of the claims of the present application, these limitations should be ignored and each claim should be interpreted only based upon limitations present therein. The Examiner includes many general comments which may or may not specifically reference language present in the claims of the present application. In addition, each of the claims should be interpreted such that no additional limitations are imputed therein, based upon comments made by the Examiner. The claims have already been drafted in an acceptable and allowable form, and no further additional amendments have been made to any of the claims.

Regarding the Examiner's comments referencing Applicants' Appeal Brief, the arguments set forth in the Appeal Brief stand on their own, and to the extent that the Examiner's comments differ from those set forth in the Appeal Brief in any way, these comments should also be ignored.

CONCLUSION

Accordingly, Applicants respectfully request allowance of each of claims 1-5 and 7-28 in connection with the present application, along with withdrawal of all outstanding objections and rejections. The Examiner has issued four (4) separate non-final Office

MP0107

09/348,865

PATENT

Actions, has withdrawn each of the various prior art rejections set forth, two (2) personal interviews has been conducted and an Appeal Brief has been filed. Thus, the piecemeal prosecution utilized by the Examiner in connection with the present application should be concluded and claims 1-5 and 7-28 should be allowed in connection with the present application. An early indication of the allowability of each of claims 1-5 and 7-28 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

DJD/bof

By: 

Donald J. Daley, Reg. No. 34,313
Attorney for Applicants

Please address all correspondence to:

Marvell Semiconductor, Inc.
700 First Avenue, Mail Stop 509
Sunnyvale, CA 94089
Customer No. 26703
Tel. No. (408) 222-2500
Fax. No. (408) 752-9034